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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,616	01/20/2004	Ruguo Hu	88265-7643	3530
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BELL, BOYD & LLOYD LLC			LEFF, STEVEN N	
P. O. BOX 1135			ART UNIT	
CHICAGO, IL 60690-1135			PAPER NUMBER	
			1761	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/761,616	Applicant(s) HU ET AL.	
	Examiner Steven Leff	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) 1-19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

- Claims 1-19 are objected to because of the following informalities:
 - In claim 1, line 12 the word “received” should be changed to receiver
 - With regard to claims 9 and 10 the word “or” in the phrase “ratio or water-soluble...” should be changed to “of”

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-11 recite the limitation "water-soluble powder". Claim 1 from which claims 9-11 depend recite “water-soluble material”. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

- Claims 1-16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marek (GB 2027662).

As to claims 1-16, Marek teaches a coffee bag, in which the bag material is made of filter paper, and may contain water -insoluble material or substance to reduce to prevent agglomeration of the coffee grains, e.g. an inert or inorganic particulate material which separates or reduces contact between the grains. The bags can also contain natural wetting agents and materials for adsorbing undesired coffee constituents, e.g. caffeine. The bag impregnating or coating materials may be pectins, agar-agar, starch syrup, carboxymethyl cellulose, and sodium salts of the latter. The coffee grains preferably have a grain size of 0.1 to 0.25 mm. (abstract)

Marek further teaches that the conventionally roasted coffee may have its flavor modified by containing coffee additives or by replacing wholly or partly the roasted coffee with coffee substitutes. (pg.1 col.1 lines 59+)

“These anti-agglomerating materials... act as a filler for preventing or reducing contact between the grains which may result in agglomeration. The materials are used in particulate form... in powder or ground form and are employed in a quantity sufficient to achieve the desired effects which may range from approximately .1 to 100%, preferably from 1 to 50 %.” (pg. 1 col. 2 line 68+)

Alternatively Marek teaches the use of an absorbent which may be a layer between the two porous sheets of filter membrane.” (pg.2 col. 1 line 105+) Although Marek does not specifically state a percentage of absorbency rate for the package, (a) it does state that the material is an absorbent, and (b) since the referenced materials meet those of the instant claims, it would be expected that the absorbent material would thus be the same, absent any clear and convincing evidence and/or arguments to the contrary.

In addition, a natural wetting agent may also be used, examples of which include saponins, (pg. 1 col. 2 line 111+) and the coffee and anti-agglomerating materials may be formed as a pellet. (pg. 2 col. 1 line 16+) To prepare the beverage Marek teaches placing the coffee bag in a cup or pot with boiling water and allowing it to soak. (pg.2 col. 1 lines 55+)

Therefore, with regard to claims 1-17 and 20 Marek teaches all of the limitations with regard to the beverage portioned package. Marek however does

not teach the placement of the beverage package within an extraction device, where the resultant beverage contains foam due to the pressure of the water being introduced into the package. The coffee bag as disclosed by Marek could perform the art recognized and applicants intended function of producing a foamy beverage by placing the coffee bag under a faucet, where the water enters through the top filter and exits through the bottom filter element where the exiting product is caught in a cup. One of ordinary skill in the art would have been motivated to use the coffee bag taught by Marek in an automatic coffee extraction device in order to more accurately control the amount of liquid, the strength and to provide a more timely manner of obtaining a coffee drink for example. Providing an automatic or mechanical means to replace a manual activity, which accomplishes the same result, is not sufficient to distinguish over the prior art. (see MPEP 2144.04III)

Therefore with regard to claims 1-16 and 20 it would have been obvious to one of ordinary skill in the art at the time of the invention by the applicant to have made or produced a beverage package with anti-agglomerating materials that is placed in an extraction device to produce a foamy beverage.

- Claims 17, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marek (GB 2027662) in view of Cai (6777007).

Marek was taken as above.

Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod. It is preferred that the first flavor-containing materials are water soluble materials such as milk or cocoa... and the second flavor-containing materials are insoluble materials such as coffee grounds." (col. 9 lines 61+)

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s)

into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder, mounting the pod holder to a beverage apparatus, introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup .

Besides filter papers, the first and second sheets can be other water-permeable thin materials such as woven or non-woven cloth, porous polymeric membranes, or thin polymer sheets with fine openings or cuts. The cuts on the thin polymer sheets are normally closed to prevent the flavor-containing materials from leaking out of the pod, but they open up when pressure is applied above the sheet. It is appreciated that the pod 30 can adopt various different shapes besides the disc shape as shown in FIG. 4.

Cai teaches the use of insoluble and soluble materials within a coffee bag to be used with an extraction machine. The fact that Cai distinguished between the materials as soluble and insoluble would lead one of ordinary skill in the art to conclude that the materials are being used partly for their art recognized purpose and applicants intended function of preventing compaction while preparing a foamy beverage. Marek teaches every limitation with regard to the specific contents of the beverage package as well as forming the coffee bag by sealing the top filter and bottom filter at their respective edges. Applicant discloses on page 6, line 11 of the specification that such an outer package configuration is typically known under the usual denomination of "filter pod." Cai teaches the applicants alternative idea of using a disc shaped surface that is pre-opened, and made of plastic. Both Cai and Marek teach a beverage made from a package or bag, however Cai further teaches the use of the package with an extraction machine. It is obvious to combine two methods, each of which is taught by the prior art to be useful for the same purpose, in order to form a third method to be used for the very same purpose, the idea of combining them flows logically from their having been individually taught in the prior art. (see MPEP 2144.06)

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Therefore with regard to claims 17, 18, and 19, one of ordinary skill in the art would have been motivated to combine the teachings of Marek and Cai to have produced a beverage package containing soluble and insoluble materials that is used in an extraction device to make a foamy coffee beverage.

Allowable Subject Matter

There is no allowable subject matter at this time.


Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: 20040005384, 4229481, 4853234, 5906845, 4826695, 6777007, 2022467, 2137243, 2027662, 2001029053. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Leff whose telephone number is (571) 272-6527. The examiner can normally be reached on Mon-Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571)272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SL



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PRIMARY EXAMINER